

Remarks/Arguments:

With the present amendment, claims 2, 3, 9-11, and 18-26 are pending. Claims 22-24 have been withdrawn. New claims 25 and 26 have been added. No new matter has been added.

Claim rejections

Claim rejections under 35 U.S.C. §103

Caillouette in view of Bachynsky

Claim 18 stands rejected under 35 U.S.C. §103(a) as unpatentable over 5,651,372 to Caillouette ("Caillouette") in view of U.S. Patent No. 5,971,953 to Bachynsky (Bachynsky"). Applicants respectfully traverse this rejection.

Amended claim 18 recites, *inter alia*, a device for needle biopsy adapted for aspiration of tissue specimens. The device comprises a syringe cylinder having a flange at an open end, a needle end disposed away from the open end, an inner wall extending between the open end and the needle end and defining an interior, and an outer wall extending between the flange and the needle end. *The outer wall has a constant outer diameter.* A plunger is displaceable within the interior of the syringe cylinder. A ventilation means comprises at least one overflow channel, which is formed at a distance from the syringe bottom in the inner wall of the cylinder, wherein the length of the channel in the direction of the cylinder axis makes it possible that the volume between the bottom and the plunger can be temporarily connected with the interior of the cylinder that is located above the plunger via at least one overflow channel.

Support for the amendments to claim 18 may be found in FIG. 12, which illustrates outer syringe wall having a constant diameter. Applicants respectfully submit that no new matter has been added.

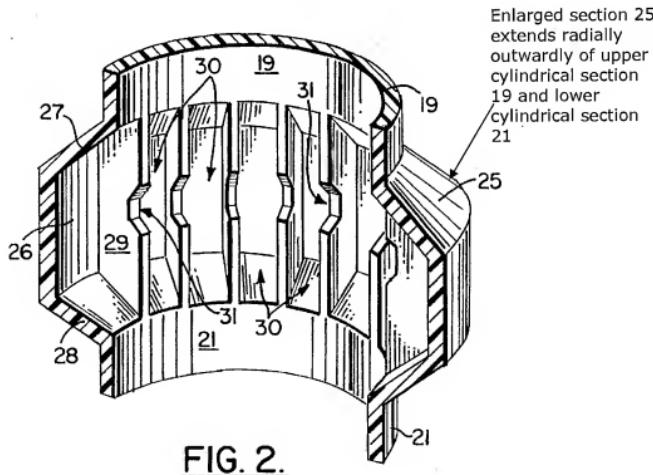
Caillouette discloses a biopsy syringe having a barrel 10 with a movable plunger 12. A side wall of barrel 10 includes an aperture 20. Caillouette, Col. 2, lines 28-29, 49-50. Aperture 20 vents air into barrel 10 when plunger 12 is withdrawn to a position behind aperture 20. *Id.*, Col. 2, lines 63-65.

Bachynsky discloses a dual chamber syringe apparatus for dispensing a dry medicine that is to be reconstituted just prior to administration to a patient. Bachynsky, Abstract, lines 1-2. The apparatus includes a syringe barrel 11 having an upper chamber 20 for containing a fluid and a lower chamber 22 containing a dry medicine or drug 24. Bachynsky, Col. 7, lines 8-12. An enlarged diameter section 25 extends between upper chamber 20 and lower chamber

22 (FIG. 1) and includes a cylindrical wall 26 and a plurality of radially and longitudinally extending ribs 29. Bachynsky, Col. 7, lines 13-19. Each pair of ribs defines therebetween a bypass flow channel 30. *Id*, Col. 7, lines 22-23. Each rib 29 has a recess 31. *Id*, Col. 7, line 20.

The Office Action alleges that Bachynsky teaches a ventilation means formed by at least one overflow channel. Office Action, page 5, lines 5-6. The Office Action also alleges that it would have been obvious to a person having ordinary skill in the art to modify the device taught by Caillouette by substituting the piston bypass means disclosed by Caillouette for the piston bypass means taught by Bachynsky in order to release a vacuum from the syringe once an adequate sample has been obtained and allows for the sample to be withdrawn while the sample is in the needle. *Id*, lines 16-21.

Claim 18 has been amended to recite that the outer wall of the cylinder has a constant outer diameter. Bachynsky, on the other hand, discloses an enlarged diameter section 25 that extends radially outwardly of upper cylindrical section 19 and lower cylindrical section 21. See, Bachynsky annotated FIG. 2 below, which illustrates how the outer wall of the cylinder *does not* have a constant outer diameter, as is recited in amended claim 18.



The enlarged outer diameter is required to allow liquid from upper chamber 20 to pass around plunger piston 32 and into lower chamber 22. Applicants respectfully submit that the proposed combination of Caillouette with Bachynsky does not provide the feature of the outer wall having a constant diameter, as is recited in amended claim 18.

Because the proposed combination of Caillouette with Bachynsky fails to establish a *prima facie* case of obviousness with respect to Caillouette and Bachynsky, Applicants respectfully request reconsideration and allowance of claim 18.

Caillouette in view of Bachynsky and Chin

Claims 2, 3, and 19 stand rejected under 35 U.S.C. §103 as unpatentable over Caillouette in view of Bachynsky and U.S. Patent No. 5,971,953 to Chin et al. ("Chin"). Claims 2, 3, and 19 ultimately depend from claim 18. Chin is cited for allegedly disclosing a device with a stop means that limits the depth of penetration of the needle into the body. The proposed combination of Caillouette with Bachynsky and Chin fails to make up the deficiencies of Caillouette and Bachynsky with respect to claim 18. Namely, Chin fails to disclose or suggest the limitation of the claimed ventilation means. Because the proposed combination of Caillouette with Bachynsky and Chin fails to disclose the claimed invention, Applicants respectfully submit that the proposed combination fails to provide a *prima facie* case of obviousness. Applicants respectfully request reconsideration and allowance of claims 2, 3, and 19.

Caillouette in view of Bachynsky and Rieck

Claim 9 stands rejected under 35 U.S.C. §103 as unpatentable over Caillouette in view of Bachynsky and U.S. Patent No. 2,551,902 to Rieck ("Rieck"). Claim 9 depends from claim 18. Rieck is cited for allegedly disclosing a device comprising a common projection sleeve that can be attached by plugging to the syringe cylinder over the needles. The proposed combination of Caillouette with Bachynsky and Rieck fails to make up the deficiencies of Caillouette and Bachynsky with respect to claim 18. Namely, Rieck fails to disclose or suggest the limitation of the claimed ventilation means. Because the proposed combination of Caillouette with Bachynsky and Rieck fails to disclose the claimed invention, Applicants respectfully submit that the proposed combination fails to provide a *prima facie* case of obviousness. Applicants respectfully request reconsideration and allowance of claim 9.

Caillouette in view of Bachynsky Dejter, Jr.

Claims 10 and 11 stand rejected under 35 U.S.C. §103 as unpatentable over Caillouette in view of Bachynsky and U.S. Patent No. 5,060,658 to Dejter, Jr. et al. ("Dejter"). Claims 10 and 11 ultimately depend from claim 18. Dejter is cited for allegedly disclosing a device with a filter means that is arranged in a path between the opening of channels into the tips of each of the at least one needle and the interior of the syringe cylinder, wherein the filter means comprises individual filter inserts in the tip-side end area of the at least one needle. The proposed combination of Bachynsky with Gibbs and Dejter fails to make up the deficiencies of Bachynsky with respect to claim 18. Namely, Dejter fails to disclose or suggest the limitation of the claimed ventilation means. Because the proposed combination of Bachynsky with Gibbs and Dejter fails to disclose the claimed invention, Applicants respectfully submit that the proposed combination fails to provide a *prima facie* case of obviousness. Applicants respectfully request reconsideration and allowance of claims 10 and 11.

Caillouette in view of Bachynsky and Ferguson

Claim 20 stands rejected under 35 U.S.C. §103 as unpatentable over Caillouette in view of Bachynsky and U.S. Patent No. 6,972,006 and U.S. Patent Application Publication No. US2004/0054332, both to Ferguson ("Ferguson"). Claim 20 depends from claim 18. Ferguson is cited for allegedly disclosing at least one indicator projection that projects from the inner wall of the cylinder. The proposed combination of Caillouette with Bachynsky with Ferguson fails to make up the deficiencies of Caillouette and Bachynsky with respect to claim 18. Namely, Ferguson fails to disclose or suggest the limitation of the claimed ventilation means. Because the proposed combination of Caillouette and Bachynsky with Ferguson fails to disclose the claimed invention, Applicants respectfully submit that the proposed combination fails to provide a *prima facie* case of obviousness. Applicants respectfully request reconsideration and allowance of claim 20.

Caillouette and in view of Bachynsky and Schwarz

Claim 21 stands rejected under 35 U.S.C. §103 as unpatentable over Caillouette and in view of Bachynsky and DE-20212639 to Schwarz ("Schwarz"). Claim 21 depends from claim 18. Schwarz is cited for allegedly disclosing a syringe device having a plurality of needles having different lengths. The proposed combination of Caillouette with Bachynsky and Schwarz fails to make up the deficiencies of Caillouette and Bachynsky with respect to claim 18. Namely, Schwarz fails to disclose or suggest the limitation of the claimed ventilation means.

Because the proposed combination of Schwarz with Caillouette and Bachynsky fails to disclose the claimed invention, Applicants respectfully submit that the proposed combination fails to provide a *prima facie* case of obviousness. Applicants respectfully request reconsideration and allowance of claim 21.

New claim 25

New claim 25 recites, *inter alia*, the device for needle biopsy according to claim 18, wherein each of the at least one overflow channel extending wholly within the constant outer diameter. Support for claim 25 may be found in FIG. 12, Detail X, which illustrates a groove 37 that extends wholly within the constant outer diameter of the cylinder.

Caillouette fails to disclose or suggest any overflow channels. Bachynsky discloses a plurality of bypass flow channels 30 that extend around the periphery of enlarged diameter section 25. Flow channels 30 all extend radially outwardly of and beyond the outer diameter of upper cylindrical section 19 and lower cylindrical section 21.

Applicants respectfully submit that, in addition to being allowable over the proposed modification of Caillouette with Bachynsky for at least the same reasons set forth above with respect to claim 18 due to the dependency of claim 25 from claim 18, claim 25 is also allowable over the proposed modification of Caillouette with Bachynsky for failing to establish a *prima facie* case of obviousness due to both Caillouette and Bachynsky failing to disclose or suggest the feature of at least one overflow channel extending wholly within the constant outer diameter.

Applicants respectfully request consideration and allowance of claim 25.

New claim 26

New claim 26 recites, *inter alia*, a device for needle biopsy adapted for aspiration of tissue specimens. The device comprises a syringe cylinder having a flange at an open end, a needle end disposed away from the open end, an inner wall extending between the open end and the needle end and defining an interior, and an outer wall extending between the flange and the needle end, the outer wall having a constant outer diameter. A plunger is displaceable within the interior of the syringe cylinder. A ventilation means comprises at least one overflow channel, which is formed at a distance from the needle end in the inner wall of the cylinder.

Each of the at least one overflow channel extends wholly within the constant outer diameter.

As discussed above with respect to claim 25, neither Caillouette nor Bachynsky discloses or suggests the feature of at least one overflow channel extending wholly within the constant

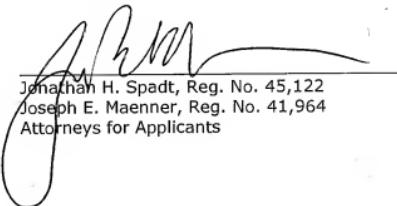
outer diameter. Further, none of the remaining applied references discloses or suggests this feature.

Applicants respectfully request consideration and allowance of claim 26.

Conclusion

In light of the above amendments and remarks, Applicants respectfully submit that the present application is in condition for allowance. Applicants respectfully request prompt consideration and allowance of the claims.

Respectfully submitted,



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